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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/765,108	01/28/2004	Shinichi Nishiyama	500.43441X00	9713

24956 7590 02/10/2006

MATTINGLY, STANGER, MALUR & BRUNDIDGE, P.C.  
1800 DIAGONAL ROAD  
SUITE 370  
ALEXANDRIA, VA 22314

EXAMINER

RENNER, CRAIG A

ART UNIT	PAPER NUMBER
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2652

DATE MAILED: 02/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/765,108

Applicant(s)

NISHIYAMA ET AL.

Examiner

Craig A. Renner

Art Unit

2652

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 January 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>On Continued Sheet</u> . | 6) <input type="checkbox"/> Other: ____.  |

IDS Mail Dates: 28 January 2004, 12 August 2004, 08 December 2004, 07 March 2005, 20 May 2005 & 04 November 2005.

## DETAILED ACTION

### *Priority*

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### *Drawings*

2. The drawings are objected to because of the following informalities:
  - a. FIGS. 1-7, 17-18 and 25-26 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g).
  - b. In FIG. 27, the two right upper-most reference signs "700" should be each changed to --800-- in order to be consistent with the remainder of the disclosure.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing

date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Specification***

3. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

4. The disclosure is objected to because of the following informalities:

a. In line 28 on page 18, lines 3 and 24 on page 19, each instance of "DC power source 800" should be changed to --DC power source 600-- in order to be consistent with the remainder of the disclosure.

b. In line 2 of claim 3, "the casing for the storage" should be changed to --the casing for the storage apparatus-- in order to more clearly refer back to that set forth in line 1 of independent claim 1.

c. In lines 4 and 11 of claim 4, each instance of "one of the casing" should be corrected to read --one of the casings--.

d. In lines 6, 8-9, and 13 of claim 4, each instance of "are received is received" should be corrected to read --is received--.

Appropriate correction is required.

5. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1-6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a. In line 10 of claim 1, it is indefinite as to which of the "plurality of disc drives," set forth in line 3 of claim 1, is being referenced by "said disc drive".

b. In line 5 of claim 2, line 2 of claim 5, and line 2 of claim 6, it is indefinite as to which of the "plurality of control boards," set forth in line 8-9 of independent claim 1, is being referenced by each instance of "said control board".

c. In lines 5-6 of claim 2, line 3 of claim 5, and line 3 of claim 6, it is indefinite as to which of the "plurality of disc drives," set forth in line 3 of independent claim 1, is being referenced by each instance of "said disc drive".

d. In lines 6-7 of claim 2, "said third receiving portion is provided in a lower portion of said second receiving portion" is indefinite as it is misdescriptive of the disclosure, which teaches/shows that the third receiving portion is provided in a lower portion below the second receiving portion (emphasis added).

e. Claims 3-4 inherit the indefiniteness associated with base claims 1 and 2 and stand rejected as well.

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being anticipated by Larabell et al. (US 5,471,099).

Larabell teaches a casing (220) comprising a first receiving portion (228), the first receiving portion being approximately equal in height and width to a disc drive box (i.e., dependent upon the height and width of the disc drive box selected); and a second receiving portion (230) being approximately equal in height and width to the first receiving portion (as shown in FIG. 6, for instance) [as per claim 1]; wherein the casing is provided with a third receiving portion (lower portion of 230), the third receiving portion is provided in a lower portion of the second receiving portion (as shown in FIG.

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6, for instance) [as per claim 2]. With respect to the intended use limitations appearing throughout claims 1 and 2, note that a recitation with respect to the manner in which a claimed apparatus (i.e., "casing") is intended to be employed (i.e., "for a storage apparatus," "for receiving a disc drive box in which a plurality of disc drives are received in a line," "for receiving a control portion box in which a plurality of control boards for executing a control relating to a data input and output process with respect to said disc drive are received in a line," and "for receiving a power source portion for supplying an electric power to said control board and said disc drive", for instance) does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations, *Ex parte Masham*, 2 USPQ2d 1647 (PTO BPAI 1987).

### ***Claim Rejections/Considerations - 35 USC § 103***

10. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

### ***Pertinent Prior Art***

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. This includes Hirano et al. (US 5,206,772), which teaches a casing having first and second receiving portions that are approximately equal in height and width.



***Allowable Subject Matter***

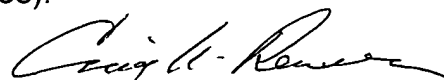
12. Claims 3-6 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

***Conclusion***

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Craig A. Renner whose telephone number is (571) 272-7580. The examiner can normally be reached on Tuesday-Friday 9:00 AM - 7:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, A. L. Wellington can be reached on (571) 272-4483. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Craig A. Renner  
Primary Examiner  
Art Unit 2652

CAR